



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,850	12/10/2003	Marvin L. Green	IN-5587	8857
26922	7590	08/28/2006	EXAMINER	
BASF CORPORATION 1609 BIDDLE AVENUE WYANDOTTE, MI 48192			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/732,850

Applicant(s)

GREEN ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/8/06
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1714

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. Application Publication No. 2002/0155278 Boisseau et al..

Boisseau discloses coating compositions and coating methods falling within the scope of the instant claims at the abstract; sections [0019], [0022], [0026] which falls within the scope of the instant claims 12 and 14, [0038]-[0043] which falls within the scope of the instant claims 9-10, [0048] of which the oligomeric film formers fall within the scope of the instant claims as they are not polymeric since they are oligomeric and they can be further polymerized and are thus monomers, [0050] which falls within the scope of the instant claim 2, [0098], [0099], [0105] which falls within the scope of the instant claim 15; and the remainder of the document.

The applicant argues that the patentee requires the film former to be oligomeric or polymeric, not monomeric. The instant claims and the enabling specification do not exclude oligomers, which are not polymers as is clear from the applicant's arguments relating to the prior 112 rejection, by recitation of "non-polymeric". The oligomers of the reference react further to give higher molecular weight polymer when cured and are therefore necessarily

Art Unit: 1714

“macromonomers” as the term is well understood in the art and are thus “monomeric”. This rejection is therefore maintained.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Application Publication No. 2002/0155278 Boisseau et al. in view of US Pat. No. 5872195 Green et al. and US Pat. No. 5756213 Ohrbom et al..

Boisseau discloses coating compositions and coating methods falling within the scope of the instant claims at the abstract; sections [0019], [0022], [0026] which falls within the scope of the instant claims 12 and 14, [0038]-[0043] which falls within the scope of the instant claims 9-10, [0048] of which the oligomeric film formers fall within the scope of the instant claims as they are not polymeric since they are oligomeric and they can be further polymerized and are thus monomers, [0050] which falls within the scope of the instant claim 2, [0098], [0099], [0105] which falls within the scope of the instant claim 15; and the remainder of the document.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed monomers of claims 4-6 as the film forming agent of Boisseau because Boisseau encompasses such film formers at sections [0048] through [0098] and Ohrbom, columns 2 through 8, which falls within the scope of the instant claims 5-6 and the ordinary skilled artisan would have expected the benefits of these film formers as taught by Green (abstract) of which compound c falls within the scope of the instant claim 4, combined with the benefits of the urea compounds of Boisseau.

The applicant argues that the patentees require the film formers to be oligomeric or polymeric, not monomeric. The instant claims and the enabling specification do not exclude oligomers, which are not polymers as is clear from the applicant’s arguments relating to the prior

Art Unit: 1714

112 rejection, by recitation of “non-polymeric”. The oligomers of the references react further to give higher molecular weight polymer when cured and are therefore necessarily “macromonomers” prior to curing as the term is well understood in the art and are thus “monomeric”. This rejection is therefore maintained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

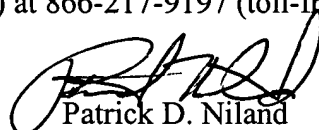
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1714

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
Art Unit 1714